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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,458	08/15/2005	Thomas Fay-Oy Lim	LC-477/PCT/US	2280

7590 07/24/2009  
STEVEN C. BAUMAN  
HENKEL CORPORATION  
1001 TROUT BROOK CROSSING  
ROCKY HILL, CT 06067

EXAMINER
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ZEMEL, IRINA SOPHIA

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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07/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/510,458	<b>Applicant(s)</b> LIM ET AL.	
	<b>Examiner</b> Irina S. Zemel	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 18-19, 24-25 is/are allowed.
- 6) ☒ Claim(s) 14-17 and 20-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 16-17, 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 still contains the clause “the alkoxysilyl groups” that lacks expressed antecedent basis.

In claims 14 and 17 refer to “the reaction product of claim 1”. However claim 1 is drawn to a two part (unreacted) composition.

Claim 16 is confusing as it claims the same composition as in claim 1, which is curable, but is uncured. It is not clear how this composition is a sound and vibrating dampening, and how it further limits claim 1.

### ***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 14-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 4,767,794 to Modic et al., (hereinafter Modic”).

The rejection stands as per reasons of record.

Once again, it is emphasized that the claimed product is drawn to a foam obtained by reacting a specific compositions, i.e., a product obtained by specific process steps. The burden was shifted to the applicants to provide factual evidence distinguishing the claimed foam from the foams obtained via different process, however no such evidence were presented.

***Claim Rejections - 35 USC § 103***

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Modic in combination with the applicants own disclosure.

The rejection stands as per reasons of record.

***Response to Arguments***

Applicant's arguments filed 4-01-2009 have been fully considered but they are not persuasive. First, it is noted that claim 15 does NOT claim a two part composition, and arguments regarding such composition as claimed in claim 15 or any limitations of claim 15 are notably absent from the applicants' arguments.

The applicants discuss what claim 14 claims and what the Modic reference discloses. The applicants then state that "It is well settled that in order to be an effective anticipatory reference, a single document must disclose each and every recitation of a claim under review." The examiner agrees with this statement. What the examiner disagrees with is the interpretation of the claimed subject matter of claims 14 and 17 as requiring to be a product obtained by a specific process. It is well settled by the law that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

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product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The examiner never alleged that the foams disclosed in Modic are obtained from reaction of the same two part composition as claimed in the instant claims. Moreover, the examiner agreed that the claimed composition is novel and patentable (by indicating the claims drawn to the composition allowable). The examiner, however, had a reasonable believe that the foams obtained from somewhat different compositions (containing the same reacting components as claimed in the instant claims) result upon curing in the product, i.e., foams that are not patentable distinguishable from the claimed foams obtained via reaction of different composition. This exact point was discussed in detail in the previous office action.

The law states that "The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). The examiner provided expressed iscussion and

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rational why the claimed foams is believed to be the same as foams disclosed in the prior art.

As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. Therefore, the burden was shifted to the applicants to provide factual evidence of patentability of the claimed product, i.e., the claimed foams. The applicants failed to provide such evidence and argues that the composition involved in reaction as claimed is different from the reactive composition disclosed in the reference. Again, such arguments are irrelevant to the claims claiming the product obtained after reacting and curing the composition. The only relevant facts for the patentability of the claimed product are the facts supporting patentable distinction of the final product, i.e.e, foam, which facts are absent from the record.

### ***Allowable Subject Matter***

Claim 16 which now claims an uncured composition and claims 20-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 1-13, 18, 19 and 24-25 are allowed.

No prior art of record discloses compositions that contain all four difference components claimed in those claims, i.e. 1) alkoxy silylcapped polysiloxane prepolymer; 2) a polyhydrogen siloxane; 3) a nitrogen-containing compound having an active

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hydrogen (primary/secondary amines) and 4) water (either in one or two-part compositions), or their uses.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/  
Primary Examiner, Art Unit 1796

Irina S. Zemel  
Primary Examiner  
Art Unit 1796

ISZ